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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,783	02/16/2001	Robert A. Foster	M-9381 US	3408
32605	7590	10/14/2004	EXAMINER	
MACPHERSON KWOK CHEN & HEID LLP 1762 TECHNOLOGY DRIVE, SUITE 226 SAN JOSE, CA 95110				FISCHER, ANDREW J
ART UNIT		PAPER NUMBER		
3627				

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/785,783	FOSTER, ROBERT A. <i>[Signature]</i>	
<b>Period for Reply</b> <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>	Examiner	Art Unit 3627	
	<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<b>Status</b> <p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>21 June 2004</u>.</p> <p>2a)<input checked="" type="checkbox"/> This action is FINAL.      2b)<input type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>			
<b>Disposition of Claims</b> <p>4)<input checked="" type="checkbox"/> Claim(s) <u>1-38</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) <u>1-8, 25 and 38</u> is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>9-24 and 26-37</u> is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8)<input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p>			
<b>Application Papers</b> <p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on _____ is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner.</p> <p style="margin-left: 20px;">Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p style="margin-left: 20px;">Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).</p> <p>11)<input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.</p>			
<b>Priority under 35 U.S.C. § 119</b> <p>12)<input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input type="checkbox"/> All    b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <p style="margin-left: 20px;">1.<input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p style="margin-left: 20px;">2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p style="margin-left: 20px;">3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p> <p>* See the attached detailed Office action for a list of the certified copies not received.</p>			
<b>Attachment(s)</b> <p>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>July 27, 2004</u></p> <p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date, _____</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____</p>			

## **DETAILED ACTION**

### ***Acknowledgements***

1. Applicant's amendment filed June 21, 2004 is acknowledged. Accordingly, claims 1-38 remain pending.
2. Claims 1-8 were withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b) as being drawn to a nonelected invention, there being no allowable generic claim. Election was made without traverse in Applicant's response filed December 15, 2003.
3. Claims 25 and 38 were also withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b) as being drawn to a nonelected species, there being no allowable linking claim. Election was made without traverse in Applicant's response filed December 15, 2003.
4. Unless expressly noted otherwise by the Examiner, the Examiner uses the following two notations in this Office Action. First, the Examiner uses lower case versions of 'applicant' to refer to *any* patent applicant while an upper case version (*i.e.* Applicant) refers specifically to the patent Applicant in this particular case. Second, the Examiner uses lower case versions of 'examiner' to refer to *any* patent examiner while an upper case version (*i.e.* Examiner) refers specifically to the Examiner of record for this application.
5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.

***Claim Rejections - 35 USC §101***

6. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 26-37 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test:

- (1) The invention must be within the technological arts; and
- (2) The invention must produce a useful, concrete, and tangible result.

8. Prong (2) requires the to produce a “useful, concrete, tangible result.” *AT&T Corp. v.*

*Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1453 (Fed. Cir. 1999); *In re Warmerdam*, 33 F3d 1354, 31 USPQ2d 1754 (Fed Cir 1994). As currently drafted, claims 26-38 reading on a computer printout and such printouts do not produce a useful, concrete, tangible result.

***Claim Rejections - 35 USC §112 2<sup>nd</sup> Paragraph***

9. The following is a quotation of the 2<sup>nd</sup> paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 9-24 and 26-37 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 9, the term “representing” makes the phrase “each first production service instance representing a first production service” indefinite because it is unclear

whether the limitations following the phrase “representing” are part of the claimed invention.

b. Also in claim 9, the phrase “the received transaction” in line 12 is indefinite. Line 2 in claim 9 recites the step of “receiving a request for a real-time price quote for a transaction . . . .” The step explicitly recites “receiving a request” and not ‘receiving a transaction.’ Because of this, there is insufficient antecedent basis for phrase “the received transaction” in the claim.

c. Claim 22 is indefinite because it does not make grammatical sense. “A claim must be read in accordance with the precepts of English grammar.” *In re Hyatt*, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983).

d. Claims 26-37 are indefinite because the scope of the claims can not be ascertained as they are directed to non statutory subject matter. If Applicant overcomes the §101 rejection(s) above, this particular 35 U.S.C. §112, 2<sup>nd</sup> paragraph rejection will be withdrawn.

11. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

***Claim Rejections - 35 USC §102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 9-24 and 26-37 are rejected under 35 U.S.C. §102(e) as being anticipated by Peterson (U.S. 6,324,522 B2)(“Peterson”). Peterson discloses the claimed invention including receiving a request for a real-time price quote for a transaction (purchasing an item); the request occurring within a billing cycle (billing cycles are inherent in commercial enterprises); determining a total (the sum of all goods, products, or services purchased); determining a billable service (shipping of the object produced, e.g. postal mail, internet, etc. inherent in commercial operations, the bill has to get to the customer somehow); the first attribute being price per unit with available volume discounts); apportioning the price to the transaction (the seller has to pay his supplier based upon the number of units he in turn received).

14. Claims 9-24 and 26-37 are alternatively rejected under 35 U.S.C. §102(e) as being anticipated by Johnson et. al. (U.S. 6,598,029 B1)(“Johnson ‘029”). Johnson ‘029 discloses a conventional e-commerce system that receives a request for a price quote, produces a widget with the widget having  $X_{Total}$  elements that make up the widget (e.g. with the widget being a computer, a computer having e.g. two optical drives making  $X_{Total} = 2$ ); determining a billable

service (shipping); calculating a price for the first production service (price of the two (2) optical drives) from a price table (inherent); based on a first attribute (an identifier for the each optical drive, *e.g.* a DVD-Rom drive has a different part number and cost than a CD-Rom drive) for the billable service (cost of shipping the optical drives, shipping costs are different for external and internal drives); and apportioning the price based upon the number of production service instances (apportioning the price based upon what the customer receives).

***Claim Rejections - 35 USC §103***

15. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 9-24 and 26-37, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Peterson.<sup>1</sup> It is the Examiner's principle position that the claims are anticipated because a table is inherent.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Peterson to include a table to store a price. One of ordinary skill in the art knows and understands that tables are used in relational databases and are commonly used to store price and other product information.

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<sup>1</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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17. Claims 9-24 and 26-37, as understood by the Examiner, are also alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson '029. It is the Examiner's principle position that the claims are also anticipated because a table is inherent.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Johnson '029 to include a table to store a price. As noted above, one of ordinary skill in the art knows and understands that tables are used in relational databases and are commonly used to store price and other product information.

18. Using the 'clear and convincing' standard, the Examiner concludes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,<sup>2</sup> the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements<sup>3</sup> with the required clarity, deliberateness, and precision.<sup>4</sup> Third, after receiving

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<sup>2</sup> See the Examiner's previous Office Action mailed March 30, 2004, Paragraph No. 12.

<sup>3</sup> "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>4</sup> "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158

express notice in the previous Office Action of the Examiner's position that lexicography is not invoked,<sup>5</sup> Applicant has not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant has not argued lexicography is invoked). Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation<sup>6</sup> to be his own lexicographer.<sup>7</sup> Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation . . . ."

*In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>8</sup> The Examiner

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F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

<sup>5</sup> See again the Examiner's previous Office Action mailed March 30, 2004, Paragraph No. 12

<sup>6</sup> *Id.*

<sup>7</sup> The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed September 28, 2004).

<sup>8</sup> See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification") (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (*en banc*); and MPEP §§ 2111 and 2111.01.

now relies heavily and extensively on this interpretation.<sup>9</sup> Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

19. To the extent that the Examiner's interpretations are in dispute with Applicant's interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.<sup>10</sup> Moreover, while the following list is provided in accordance with *In re Morris*, the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.<sup>11</sup> Finally, the following list is not intended to be exhaustive in any way:

**Computer:** "Any machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output." Computer Dictionary, 3<sup>rd</sup> Edition, Microsoft Press, Redmond, WA, 1997.<sup>12</sup> **Client:** "3. On a local area network or

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<sup>9</sup> See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . [Emphasis added.]"

<sup>10</sup> While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

<sup>11</sup> See e.g. *Brookhill-Wilk I LLC v. Intuitive Surgical Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003) (abstract dictionary definitions are not alone determinative; "resort must always be made to the surrounding text of the claims in question").

<sup>12</sup> Based upon Applicant's disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as "a technical dictionary" to define the term "flag." See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its

Internet, a computer that accesses shared network resources provided by another computer (called a server).” *Id.* *Server:* “2. On the Internet or other network, a computer or program that responds to commands from a client.” *Id.*

*Table* “1. In programming, a data structure usually consisting of a list of entries, each entry being identified by a unique key and containing a set of related values. A table is often implemented in an array of records, a linked list, or (in more primitive languages) several arrays of different data types all using a common indexing scheme. 2. In relational databases, a data structure characterized by rows and columns, with data occupying or potentially occupying each cell formed by a row-column intersection. The table is the underlying structure of a relation.” *Id.*

“*Billing Cycle* interval between periodic billings for goods sold or services rendered, normally one month, or a system whereby bills or statements are mailed at periodic intervals in the course of a month in order to distribute the clerical workload evenly (see *Cycle Billing*).”

Dictionary of Business Terms, 3<sup>rd</sup> Edition, Barron’s Educational Series, Inc., 2000.

20. Regarding claims 9-24, functional recitation(s) using the word “for” or other functional terms (e.g. “for real-time pricing” as recited in claim 9) have been considered but given less patentable weight<sup>13</sup> because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a

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appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled ‘New Terminology.’

<sup>13</sup> See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

21. Additionally, the Examiner notes that “the PTO and the CCPA acknowledged product-by-process claims as an exception to the general rule requiring claims to define products in terms of structural characteristics.” *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 845, 23 USPQ2d 1481, 1490 (Fed. Cir. 1992) (hereinafter “*Atlantic Thermoplastics v. Faytex I*”). Furthermore, the Federal Circuit “acknowledges that it has in effect recognized . . . product-by-process claims as exceptional.” *Atlantic Thermoplastics v. Faytex I*, 970 F.2d at 847, 23 USPQ2d at 1491.

Because of this exceptional status, the Examiner has carefully reviewed the claims and it is the Examiner’s position that claims 9-24 and 26-37 *do not* contain any product-by-process limitations whether in a conventional format or otherwise. If Applicant disagrees with the Examiner, the Examiner respectfully requests Applicant in his next properly filed response to expressly point out any product-by-process claim(s) and their limitations so that they may be afforded their exceptional status and treated accordingly. Applicant is reminded that “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.” *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).<sup>14</sup> Failure by Applicant in his next response to also address this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered intent by Applicant *not* to recite any product-by-process limitations.

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<sup>14</sup> See also MPEP §2113.

Unless expressly noted otherwise by the Examiner, the preceding discussion on product-by-process principles applies to all examined claims currently pending.

***Response to Arguments***

22. Applicant's arguments filed June 21, 2004 have been fully considered but they are not persuasive.

***Peterson***

23. Applicant refers to claims 9 and 26 and argues that "The Examiner's interpretation of the term 'billing service' is not a reasonable interpretation, since the term 'billing service was not used in the sense of 'a service by which the bill is delivered to the customer' in Applicant's specification and claims."<sup>15</sup>

24. In response, the Examiner has carefully reviewed claims 9 and 26. It is the Examiner's factual determination that claims 9 and 26 do not recite 'a service by which the bill is delivered to the customer.' Applicant's argument is therefore not persuasive. As Judge Clevenger has so eloquently summarized these types of arguments, "The invention disclosed in [Applicant's] written description may be outstanding in its field, but the name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

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<sup>15</sup> Applicant's Remarks filed June 21, 2004, Page 11, last three lines.

***Johnson '029***

25. Applicant's arguments regarding Johnson '029 have been considered but are not persuasive.

***Lexicography***

26. Applicant's response regarding lexicography is acknowledged. While the Examiner respectfully disagrees, Applicants' traversal is noted for the record.

27. First, the Examiner has never *required* Applicant to be his own lexicographer. It is Applicant's burden to define his invention, not the Examiner's.<sup>16</sup> In complying this burden, Applicant is reminded that it is the Applicant—and *not* the Examiner—who drafted the claims, specification, and drawings and it is therefore the *Applicant* who must decide whether or not to be his own lexicographer.<sup>17</sup> Along the same line of reasoning, whether or not Applicant uses this or that particular method of claim construction (*e.g.* lexicography or perhaps 35 U.S.C. §112 6<sup>th</sup> paragraph) is also completely within Applicant's discretion.

28. Second, Applicant is reminded that claim terminology is fixed upon filing. See *Middleton Inc. v. Minnesota Mining and Manufacturing Co.*, 311 F.3d 1384, 1389, 65 USPQ2d 1138, 1142 (Fed. Cir. 2002) (“The meaning of a patent term, however, is not subject to revision . . . The meaning of patent terms depends on the usage of those terms in context by one of skill in

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<sup>16</sup> *In re Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029 (quoting 35 U.S.C. §112 2<sup>nd</sup> paragraph, “It is the applicants’ burden to precisely define the invention, not the PTO’s.”).

<sup>17</sup> See *e.g. Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 USPQ 1025, 1031 (Fed. Cir. 1984) (noting that “It is the inventor applying for a patent who is permitted to be his own lexicographer,” not the examiner).

the art *at the time of application*. [Emphasis added.]”); *Wiener v. NEC Elecs., Inc.*, 102 F.3d 534, 539, 41 USPQ2d 1023, 1027 (Fed. Cir. 1996) (“Ultimately, a court must construe the claim language according to the standard of what those words would have meant to one skilled in the art *as of the application date*. [Emphasis added.]”) (overruled on other grounds in *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454-55, 46 USPQ2d 1169, 1173 (Fed. Cir. 1998) (en banc)); *Plant Genetic Systems N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1345, 65 USPQ2d 1452, 1460 (Fed. Cir. 2003) (“We hold that the district court did not ignore the plain meaning of the claims, but properly gave objective meaning to them as they were understood *at the time the patent application was filed*. [Emphasis added.]”); ~~and~~ *Kopykake Enterprises Inc. v. Lucks Co.*, ~~GAJ~~ 264 F3d 1377, 1383, 60 USPQ2d 1124, 1127 (Fed. Cir. 2001) (“[W]hen a claim term understood to have a narrow meaning when the application is filed later acquires a broader definition, the literal scope of the term is limited to what it was understood to mean *at the time of filing*. [Emphasis added.]”); and *In re Bass*, 314 F.3d 575, 577-78, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (noting that “Bass chose to define ‘motorized sports boat’ in the specification. He cannot change or modify that definition on appeal.”).

So once an applicant files his or her specification, the meaning of *all* claim terms—both lexicographic and non-lexicographic—are fixed. While the meaning may be ‘uncovered,’ ‘corralled,’ or ascertained during either ex parte examination or inter partes litigation,<sup>18</sup> the meaning of claim terms nevertheless remains fixed. It is self evident that failure to construe a

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<sup>18</sup> See e.g. *Jack Gluttmann, Inc. v. Kopykake Enterprises, Inc.*, 302 F.3d 1352, 1360, 64 USPQ2d 1302, 1307 (Fed. Cir. 2002) (“Where, as here, the patentee has clearly defined a claim term, that definition usually is dispositive; it is the single best guide to the meaning of a disputed term.”).

claim during either ex parte examination or inter partes litigation does not change the fact that the meaning of claim terms is fixed upon filing. And terms or definitions that actually *change* claim meaning by their inclusion *after* the filing date of the application are improper under either 35 U.S.C. §112 1<sup>st</sup> paragraph and/or 35 U.S.C. §132 since it is axiomatic that any *change* from an initial meaning would clearly constitute new matter.

29. Third, the Examiner recognizes that drafting patent applications is a complicated process requiring the drafter to consider many complex issues.<sup>19</sup> However this does not relieve the drafter of deciding whether or not to be his or her own lexicographer and if affirmative, unequivocally stating those definitions in the specification. Such definitions and associated issues must be contemplated *prior to* filing the patent application. See *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 21 USPQ2d 1383 (Fed. Cir. 1992) noting that for lexicography and quoting *Lear*, “the place to do so is in the specification of the inventor’s application, and the time to do so is *prior to* that application acquiring its own independent life as a technical disclosure through its issuance as a United States patent. [Emphasis added.]” *Intellicall*, 952 F.2d at 1388, 21 USPQ2d at 1386.

30. Having established that claim terms are fixed upon filing and that Applicant is the master of his domain, the Examiner has simply required that if Applicant *knows of* a lexicographic definition or if Applicant *intended to be* his own lexicographer, the Examiner respectfully requested that he point it out now. After the Examiner has brought this issue to Applicant’s attention and after the Examiner has shown reliance on the *lack* of lexicographic definition(s) to

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<sup>19</sup> See e.g. *Johnson & Johnston Associates*, 285 F.3d at 1069, 62 USPQ2d at 1241, Newman, J., dissenting (“Patentees often must draw lines in order to claim their invention with specificity.”).

interpret the claims, Applicant's continued failure to point out any *known* lexicographic definition(s) would be violation of 37 C.F.R. §1.111(b),<sup>20</sup> and perhaps, Applicant's duty of candor and good faith under 37 C.F.R. §1.56 which states in part: "(a) ... Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office . . . ." In any event, one point however is clear, such comments by Applicant unmistakably confirm that Applicant has received notice of the Examiner's factual findings and legal conclusions regarding lexicography invocation and has been given an opportunity to defend against the noticed liabilities.

31. Finally, Applicant states:

As the number of claim terms in the 38 claims is large, and as there is no definitive source of 'ordinary and customary meanings' that is recognized and relied on by those skilled in the art, Applicant respectfully submits that such a blanket requirement is unreasonable. Further, Applicant believes that it is entitled to disclaim the broadest reasonable interpretation of a claim term, so as to adopt a narrowing meaning consistent with its use in the specification and file history, if and when it appears that such broadest reasonable interpretation would encompass prior art. Therefore, without reference to any prior art, a requirement for Applicant to define a claim term *apriori* and in the abstract is unreasonable, as such definition may materially affect the scope of a claim to which Applicant is entitled.<sup>21</sup>

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<sup>20</sup> For additional guidance on how the USPTO interprets 37 C.F.R. §1.111(b) see e.g.: MPEP §818.03(a) quoting §1.111(b) and noting that applicant is required to point out the supposed errors in the next response by stating *why* the Examiner's position regarding restriction is *substantively* incorrect in order to preserve his or her right to petition; MPEP §2144.03 regarding Official Notice noting that traversal must be made in applicant's *next response*. "A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well known statement *in the next reply* after the Office action in which the well known statement is made. [Emphasis added.]" Failure to seasonable challenge the official noticed statement *in the very next response* means the statement is interpreted as admitted prior art; and *In re Goodman*, 3 USPQ2d 1866, 1871 (ComrPats 1987) noting the examiners have no authority to waive 37 C.F.R. §1.111(b) and that an applicant is required to point out *any* supposed errors in his next response.

<sup>21</sup> Applicant's Remarks filed June 21, 2004, Page 13.

32. First, complaining about the size of the claim is not persuasive. As noted above, Applicant drafted the claims—not the Examiner.

33. Second, there are source(s) for an ‘ordinary and accustomed meaning.’ See e.g. the Computer Dictionary, *supra*.

34. Third, Applicant’s belief that he “is entitled to disclaim the broadest reasonable interpretation of a claim term, so as to adopt a narrowing meaning consistent with its use in the specification and file history, if and when it appears that such broadest reasonable interpretation would encompass prior art” is simply false. Patent applicants are *not free* to invoke lexicography or change claim interpretation “if and when” their claim is rejected. Either applicants *are* already their own lexicographer or they are not. As noted above, it is the Examiner’s position that in this particular case, Applicant was not his own lexicographer. Furthermore, while prosecution disclaimer (and associated issues) may have its genesis in ex parte examination, the Examiner is unaware of a *single* case invoking prosecution disclaimer during ex parte examination. See *Omega Engineering Inc. v. Raytek Corp.*, 334 F.3d 1314, 67 USPQ2d 1321 (Fed. Cir. 2003) for an excellent discussion on this topic.

35. Applicant’s statement that “a requirement for Applicant to define a claim term *apriori* and in the abstract is unreasonable” is clearly not supported in law. Because of these and other erroneous statements of law, the Examiner will briefly review some ‘Fundamental Principles’ and canons of claim construction.

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***The Fundamental Principle That Claims Define The Scope Of Patent Protection***

36. The first step in establishing a prima facie case of anticipation obviousness is construing the claims.<sup>22</sup> Claim construction is a question of law. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454, 46 USPQ2d 1169, 1174 (Fed. Cir. 1998) (en banc). Additionally, “[i]t is the *claims* that measure the invention. [Emphasis in original.]” *Johnson & Johnston Associates Inc. v. R.E. Service Co.*, 285 F.3d 1046, 1052, 62 USPQ2d 1225, 1228 (Fed. Cir. 2002) (en banc) (citations omitted).<sup>23</sup> The en banc court in *Johnson & Johnston Associates* noted that not only did the claims legally define the invention,<sup>24</sup> the claims also provided the necessary notice regarding the scope of protection.

Both the Supreme Court and this court [the Federal Circuit] have adhered to the *fundamental principle* that claims define the scope of patent protection. The claims thus give notice of the scope of patent protection. The claims give notice both to the examiner at the U.S. Patent and Trademark Office during prosecution, and to the public at large, including potential competitors, after the patent has issued.

Consistent with its scope definition and notice functions, the claim requirement presupposes that a patent applicant defines his invention in the claims, not in the specification. *Johnson & Johnston Associates*, 285 F.3d at 1052, 62 USPQ2d at 1228-29 (citations omitted). [Emphasis added.]

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<sup>22</sup> See *United States Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 41 USPQ2d 1225, 1236 (Fed. Cir. 1997)(“Claim construction is a matter of resolution of disputed meanings and technical scope, to clarify and when necessary to explain what the patentee covered by the claims . . .”).

<sup>23</sup> See also *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121, 227 USPQ 577, 586 (Fed. Cir. 1985) (en banc) (noting that it is the claim language which defines claim scope); and *Tate Access Floors Inc. v. Interface Architectural Resources Inc.*, 279 F.3d 1357, 1370, 61 USPQ2d 1647, 1656 (Fed. Cir. 2002)(“Claim interpretation begins, as always, with the language of the claims.”).

<sup>24</sup> See also *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1369, 59 USPQ2d 1745, 1748 (Fed. Cir. 2001) (“The purpose of claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant.”) (citations omitted).

37. Next, when construing claims “[t]he general rule is, of course, that terms in the claim are to be given their ordinary and accustomed meaning.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d at 989, 50 USPQ2d at 1610. In other words, “there is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.” *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (citations omitted).<sup>25</sup>

38. It must be noted that to overcome this “heavy presumption” in favor of the ordinary and accustomed meaning, a party must do so by ‘clear and convincing’ evidence.<sup>26</sup> Because the use of a “presumption” alone implies just a ‘preponderance of the evidence,’<sup>27</sup> it is the Examiner’s position that the use of the phrase “heavy presumption” or “strong presumption” implies a standard *higher* than a preponderance. In other words, if e.g. a party needed only ‘preponderance of the evidence’ to invoke lexicography, the Federal Circuit would have simply

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<sup>25</sup> See also *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (“We indulge a heavy presumption that a claim term carries its ordinary and customary meaning.”) (citations and quotations omitted); and *Deering Precision Instruments L.L.C. v. Vector Distribution Systems Inc.*, 68 USPQ2d 1716, 1721 (Fed. Cir. 2003) (“Generally speaking, we indulge a ‘strong presumption’ that a claim term carries its ordinary and customary meaning.”) citing *Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, 279 F.3d 1357, 1369, 61 USPQ2d 1647 (Fed. Cir. 2002).

<sup>26</sup> Clear and Convincing Proof: “That proof which results in reasonable certainty of the truth of the ultimate fact in controversy. Proof which requires more than a preponderance of the evidence but less than proof beyond a reasonable doubt. Clear and convincing proof will be shown where the truth of the facts asserted is highly probable.” Black’s Law Dictionary, Abridged 6th Ed., West Publishing Co., 1991.

<sup>27</sup> Preponderance of the Evidence : “The greater weight of the evidence; the burden of proof in a civil trial which the jury is instructed to find for the party that, on the whole, has the stronger evidence, however slight the edge might be. —Also termed *preponderance of proof*, *balance of probability*. Cf. *clear and convincing evidence* under EVIDENCE.” Id.

used ‘presumption’ instead of “*heavy* presumption.” So that the word “heavy” or “strong” is not vitiated, the standard for lexicography invocation must be at least *greater than* a ‘preponderance of the evidence.’ And because ‘clear and convincing evidence’ is the next standard above ‘preponderance of the evidence,’<sup>28</sup> logic dictates that the standard for lexicography invocation (at least *inter partes* litigation) must be ‘clear and convincing evidence.’

39. As note above, during *ex parte* examination, claims are given their “broadest reasonable interpretation . . . .” *In re Morris*, 127 F.3d at 1054, 44 USPQ2d at 1027; *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).<sup>29</sup> In fact, the requirement that an examiner interpret the claims with the “broadest reasonable interpretation” is not optional; “an examiner has the *duty* to police claim language by giving it the broadest reasonable interpretation . . . . [Emphasis added.]” *Spring Window Fashions LP v. Novo Indus., L.P.*, 323 F.3d 989, 994, 65 USPQ2d 1826, 1830 (Fed. Cir. 2003) (citations omitted).

40. While the Examiner noted above that the ‘clear and convincing’ standard is the standard need to invoke lexicography during *inter partes* litigation, logic dictates that is it is also the standard for lexicography invocation—and thus deviation from a term’s “broadest reasonable interpretation”—during *ex parte* examination.

41. Consistent with *Morris*, the “broadest reasonable interpretation” of a term used during *ex parte* examination includes but is not limited to, all of the term’s ordinary and accustomed

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<sup>28</sup> See e.g. *Buildex Inc. v. Kason Indus., Inc.*, 849 F.2d 1461, 1463, 7 USPQ2d 1325, 1327 (Fed. Cir. 1988) (noting that the ‘clear and convincing’ standard is an intermediate standard which lies between ‘beyond a reasonable doubt’ and a ‘preponderance of the evidence.’)(citations omitted).

<sup>29</sup> See also MPEP §2111; *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

meanings.<sup>30</sup> In fact, in ex parte cases, the Federal Circuit sometimes interchanges or substitutes “broadest reasonable interpretation” with ‘ordinary and accustomed meaning.’ See e.g. *In re Bass*, 314 F.3d at 577, 65 USPQ2d at 1158 (“In examining a patent claim, the PTO must apply the *broadest reasonable meaning* to the claim language . . . . Words in a claim are to be given their *ordinary and accustomed meaning* unless the inventor chose to be his own lexicographer in the specification. [Emphasis added.”).

42. Moreover, arguments that the ‘clear and convincing evidence’ standard for lexicography invocation arises only after issuance and thus applies only to the inter partes litigation (*i.e.* ‘ordinary and accustomed meaning’) are equally unpersuasive. The Examiner agrees that 35 U.S.C. §282 bestows a presumption of *validity* on issued patents. Therefore differing standards arise for *validity* (or invalidity) purposes only. See e.g. *In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985) (“From *In re Etter*, 756, F.2d 852, 225 USPQ 1 (Fed. Cir. 1985) (en banc), it is apparent that, due to 35 U.S.C. §282, the standard of proof required to properly reject the claims of a patent application is necessarily lower than that required to invalidate patent claims”). However as noted earlier, claim construction is a question of law and is not necessarily a *validity* determination. Therefore 35 U.S.C. §282 can not change the standard for claim

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<sup>30</sup> Note that the converse is not necessarily true. Not all ‘broadest reasonable interpretations’ fit within a term’s ‘ordinary and accustomed meanings.’ See e.g. *Intellectual Property Development Inc. v. UA-Columbia Cablevision of Westchester Inc.*, 336 F.3d 1308, 1315, 67 USPQ2d 1385, 1390 (Fed. Cir. 2003)(while *Morris* allows virtually all reasonable dictionary definitions within the rubric of the ‘broadest reasonable interpretations,’ the court in this case noted that “the dictionary definition that is most consistent with the specification and the prosecution history is the definition that defines ‘high frequency’” and thus becomes the ordinary and accustomed meaning).

construction.<sup>31</sup> In other words, §282 can not bestow any deference between two valid claim constructions. Because 35 U.S.C. §282 can not change the standard for claim construction, if ‘clear and convincing evidence’ is the standard used during inter partes litigation to determine if an applicant desires to be his or her own lexicographer, the Examiner concludes that ‘clear and convincing evidence’ is the standard needed to invoke lexicography during ex parte examination. In this case, it is the Examiner position that based upon clear and convincing evidence, Applicant has chosen not to be his own lexicographer.

### ***Why is this Important?***

43. “It is black letter law that a patentee can choose to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term that could differ in scope from that which would be afforded by its ordinary meaning.” *Jack Gluttmann, Inc.*, 302 F.3d at 1360, 64 USPQ2d at 1307 (citations and quotations omitted). “In short, the presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning.” *Texas Digital*, 308 F.3d at 1204, 64 USPQ2d at 1819 (a claim’s ordinary meaning, which in this case was a dictionary definition, is overcome if patentee is acting as their own lexicographer).

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<sup>31</sup> Cf. how ‘preponderance of the evidence’ is the standard used in *both* ex parte examination and inter partes actions to invoke 35 U.S.C. §112 6<sup>th</sup> paragraph. The use of “means” as a presumption for invoking §112 6<sup>th</sup> paragraph (and thus the *standard* for invoking §112 6<sup>th</sup> paragraph) applies equally to both ex parte examination and inter partes litigation alike. Determining the invocation of §112 6<sup>th</sup> paragraph is therefore not a *validity* determination.

44. There are many two (2) primary reasons for invoking lexicography. First, an applicant may use lexicography when he or she is unsure of a term's meaning or when an applicant desires to define an entirely new term. "This is done in order to hold open the possibility of obtaining a patent where an inventor is not schooled in the terminology of the technical art to which his invention pertains or where there is a need to coin new expressions with which to communicate that invention." *Lear Siegler, Inc. v. Aeroquip Corp.*, 221 USPQ at 1031 (citations omitted).

45. Second and more commonly used, lexicography may be used to *redefine* a claim term which already processes a clear, ordinary and accustomed meaning. "But even where the claim language is not ambiguous, the prosecution history limits the interpretation . . . Thus, the prosecution history limits even clear claim language . . ." *Schumer v Laboratory Computer Systems, Inc.*, 308 F.3d 1304, 1313, 64 USPQ2d 1832, 1839 (Fed. Cir. 2002) (citations and quotations omitted).

46. This 'redefined term' or lexicographic definition is not limited by known usages either. The redefined term or lexicographic definition may be *contrary to* or *inconsistent with* one or more of the term's ordinary meanings. "It is a well-established axiom in patent law that a patentee is free to be his or her own lexicographer and thus may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings." *Hormone Research Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1563, 15 USPQ2d 1039, 1043 (Fed. Cir. 1990). The redefined term or lexicographic definition may also *expand* or *further limit* the known ordinary and accustomed meanings. "A patent applicant may consistently and clearly use a term in a manner either more or less expansive than its general usage in the relevant art, thereby expanding

or limiting the scope of the term in the context of the patent claims.” *Alloc Inc. v. ITC*, 68 USPQ2d 1161, 1165 (Fed. Cir. 2003).

47. A redefined term or lexicographic definition is of particular importance during ex parte examination because it is the *primary* way to overcome the broadest reasonable interpretation. In other words, when an applicant acts as his or her own lexicographer and successfully redefines a claim to have a meaning other than its ordinary and accustomed meaning, the claims must be examined using that meaning. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“When the Applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the Applicant's invention and its relation to the prior art.”).<sup>32</sup>

48. To that end and with the ‘clear and convincing evidence’ standard noted above, it is *Applicant's burden* to overcome the ordinary and accustomed meaning or broadest reasonable interpretation—not the Examiner's. “[A] party wishing to alter the meaning of a clear claim term must overcome the presumption that the ordinary and accustomed meaning is the proper one, demonstrating why such an alteration is required.” *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 52 USPQ2d 1001, 1004 (Fed. Cir. 1999)(citations omitted). With lexicography in particular, this means that applicants must demonstrate that they have redefined a claim term with the required clarity, deliberateness, and precision. See again *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d at 1249, 48 USPQ2d at 1121 citing *In re Paulsen*, 30 F.3d at 1480, 31 USPQ2d at 1674, *supra*.

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<sup>32</sup> See also MPEP §2173.05(a).

49. In this case, because Applicant has not overcome the heavy presumption in favor of the ordinary and accustomed meaning, it is the Examiner's position that Applicant is not, or more precisely, *was* not his own lexicographer. While Applicant's statement that such definitions "may" materially affect the scope of a claim is technically true, it is only a partial statement of law; such statements *do* in fact affect the scope of a claim.

### ***Conclusion***

50. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

51. References considered pertinent to Applicant's disclosure are listed on form PTO-892.

52. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8<sup>th</sup>

Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

53. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

54. Also in accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the Borland's Paradox for Windows User's Guide is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The reference is cited in its entirety. Paradox for Windows User's Guide exemplifies a typical relational database system. Because of the reference's basic content (which is self-evident upon examination of the reference) and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that the Paradox for Windows User's Guide is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within the reference.

55. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is

*not* a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

56. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his “Remarks” (beginning on page 10) traversing the Examiner’s positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>33</sup> the Examiner respectfully reminds Applicant to properly traverse the Examiner’s position(s) in

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accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.

A handwritten signature in black ink that reads "AJ Fischer 9/27/04". The signature is fluid and cursive, with "AJ" and "Fischer" connected.

Andrew J. Fischer  
Primary Examiner  
Art Unit 3627

AJF

September 27, 2004.

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<sup>33</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.